

Atty. Dkt. No. 041673-2007

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A. **Rejection Of Claims 1 And 2 Under Section 112, For Failure To Disclose "Essential Matter", And Objection To Specification On The Same Grounds.**

In response to the previous action's objections to the drawings, Applicants withdrew the drawings from the application as being unnecessary to enable one of ordinary skill in the art to practice the invention. The claims and the specification are now objected to as failing to include essential matter; i.e., a listing of amino acids 1-292 of the *Drosophila Sog* protein, which comprise the fragment that is the subject of the present claims.

M.P.E.P. § 608.01(p) (part I.A) defines "essential material" as "that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode." In other words, information necessary for the application to meet the requisites of Section 112, first paragraph.

However, not all material necessary to describe the invention need be reiterated within the application. Indeed, it is axiomatic that the specification **need not teach**, and preferably omits what is well known in the art to fully and completely describe the invention. *General Electric Company v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (DC Cir. 1968). Thus, if an aspect of the invention is known in the art (such as the full length, wild-type coding sequence for the *Sog* protein), the decision not to include such information in the written description of an invention cannot be considered to be a failure to include 'essential material' necessary to describe and enable the claimed invention.

Here, the sequence of the *Drosophila Sog* protein is both publicly accessible and well-known. Thus, by identifying the claimed portion of the protein as the first 292 amino acids (the location of which within the overall protein is well described in the specification; see, e.g., page

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4, lines 1-2 and page 5, lines 6-11), the specification and claims unambiguously define the invention for those of ordinary skill in the art.

Nonetheless, for the sake of expedient prosecution, a declaration averring that the sequence listing submitted (with corrections) on July 19, 2000 sets forth the same material as set forth in the Francois, et al., reference, per the Examiner's suggestion on page 4 of the Office Action, is submitted herewith. Reconsideration and withdrawal of the rejection and objection made under Section 112, first paragraph is respectfully requested.

B. **Rejection of Claims 1 and 2 Under Section 102, Over Schmidt.**

Claims 1 and 2 are rejected under Section 102(b) on the basis of Schmidt's disclosure of an expression vector encoding the full-length, wild-type Sog protein (see, page 4320, first paragraph, column 2: "This vector (Sog25) produced wild-type sog RNA.").

However, Applicant's do not claim a vector which produces wild-type Sog protein, or any other full-length version of the protein. Instead, only the first 292 amino acids of the protein are produced by the polynucleotide of the invention; i.e., the "Super-Sog" polypeptide, defined as consisting of the first 292 amino acids of the Sog protein (Specification at page 3, lines 1-2). Applicant respectfully submits that the claim as presently is clear in this respect, and therefore not anticipated by Schmidt.

At page 4 of the Office Action, the Examiner appears to agree, stating that "[a]n isolated nucleic acid molecule encoding an amino acid sequence consisting of amino acids 1-292 of the *Drosophila* Sog protein is free of the prior art of record." In this respect, Claim 1 is amended herein to reflect the wording used in the Office Action by the Examiner by specifying that the encoded polypeptide "consists of" amino acids 1-292 of Sog.

No such polypeptide, especially not one having the inhibitory activity of Super-Sog, is disclosed or suggested by Schmidt. As such, reconsideration and withdrawal of the rejection of Claims 1 and 2 under Section 102(b) over Schmidt is respectfully requested.

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This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claim 1 is now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date 10 - 7 - 03

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